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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,747	07/09/2003	Mu-Fa Lin	13847 B	2762
7590	12/01/2004		EXAMINER	
CHARLES E. BAXLEY HART, BAXLEY, DANIELS & HOLTON 90 JOHN STREET, THIRD FLOOR NEW YORK, NY 10038			NASH, BRIAN D	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/616,747	LIN, MU-FA <i>CA</i>
	<b>Examiner</b>	<b>Art Unit</b>
	Brian Nash	3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 30 August 2004.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,6,9 and 12-14 is/are rejected.
- 7) Claim(s) 3-5,7,8,10 and 11 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 13, line 3, the term "rid" is vague, indefinite, and confusingly worded because it is not clear what applicant is claiming.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 6, 9, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,585,154 to Fealey et al. Fealey et al disclose the invention substantially as claimed including a nail magazine used in a power tool to hold and feed a

rolled belt of nails, the magazine having a shaft (106) vertically disposed inside a circular casing (36) at its center, the casing having a circular bottom wall (76), a cover (50) hingedly connected thereto (via 114) and defining a nail feed hole when in a closed position; the casing also having a stepped (74,80) nail feeding wall in a peripheral open side thereof. Fealey et al do not show a nail carrier sleeve vertically movably mounted around the shaft; however, the shaft (106) of Fealey et al in combination with the biasing spring (116) perform the same function of applicant's invention, i.e. the belt of connected nails are guided and biased toward rotational movement about the central axis of the shaft (106) as the leading portion of the belt is fed to the nail feeding mechanism (34) (see column 7, lines 50-68, Fig. 4). It would have been an obvious matter of design choice to use a biasing spring mounted around the shaft since applicant has not disclosed that the biasing spring itself solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with either design choice.

The examiner notes that little patentable weight has been given to the limitations of the "L-shaped" nail described in the preamble of claim 1. Applicant's invention is directed toward a nail magazine and is claimed as such. The claimed structural limitations of the magazine do not depend on the preamble for completeness, but instead are able to stand alone.

Regarding claim 12, Fealey et al do not disclose the use of a wear resistant face disposed at a bottom side of the nail feed hole. Official Notice is taken that both the concept and advantages of providing a wear resistant material for improved tool operation and longer tool life are well known and expected in the art. It would have been

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obvious to have included a wear resistant material at such a location subject to increased friction in order to prolong the life of the tool.

***Allowable Subject Matter***

6. Claims 3-5, 7-8, and 10-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hillier, Fisher, Monacelli, Stich, Leitner, and Gabriel are cited to show related references.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467.

The official fax number for this Group is: 703-872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

Brian Nash  
26 November 2004



Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700